

REMARKS

This application pertains to a novel pressure-sensitive adhesive which adheres well to polar plastic surfaces, metal surfaces and glass surfaces, yet adheres only weakly or not at all to paper, paperboard or human skin.

Claims 1-19 are pending.

Claims 1-3, 6, 10-14 and 19 stand rejected under 35 U.S.C. 103(a) as obvious over Grindley (GB 1,216,672) in view of Ganster (US 6,191,216). The Examiner views Grindley as disclosing pressure-sensitive urethane adhesives comprising triols having a molecular weight of greater than 1000 and diols having a molecular weight less than 1000 and made at a NCO/OH ratio of 1/1; as well as disclosing aliphatic and aromatic diisocyanates. The Examiner then turns to Ganster for a teaching that aliphatic diisocyanates are preferable to aromatic diisocyanates for adhesives that contact the skin, and also for a teaching of bismuth catalysts. From this, the Examiner concludes that it would be obvious to use Ganster's aliphatic diisocyanate and bismuth catalyst for Grindley's adhesive, and that this presumably would lead to Applicants' novel adhesives.

Although the Examiner reads Grindley as disclosing triols having a molecular weight of greater than 1000 and diols having a molecular weight less than 1000 and made at a NCO/OH ratio of 1/1, Applicants do not see where this disclosure can be found anywhere in Grindley. The example that the Examiner refers to discloses triols only, and no diols! In the example, a triol is reacted with a toluene

diisocyanate; and there are no diols involved. Furthermore, there is no teaching or suggestion of a NCO/OH ratio of 1/1. The Ganster reference, in fact, teaches a NCO/OH index of 0.3 to 0.7 (col. 4, line 23). This would teach away from Applicants' ratio of between 0.8 and 1.15. In addition, Nothing in Grindley or Ganster teaches or suggests the use of at least one aliphatic or alicyclic polyisocyanate having a functionality of less than or equal to three, as is required by Applicants' main claim.

Moreover, none of the specific polyisocyanates recited in Applicants' claim 3 are taught or suggested anywhere in the Grindley/Ganster combination of references.

The Grindley/Ganster combination of references do not teach or suggest any element of Applicants' claims whatsoever! There is no teaching or suggestion of Applicants' diols, no teaching or suggestion of Applicants' NCO/OH ratio, and no teaching or suggestion of Applicants polyisocyanates having a functionality of three or less.

The rejection of claims Claims 1-3, 6, 10-14 and 19 under 35 U.S.C. 103(a) as obvious over Grindley (GB 1,216,672 in view of Ganster (US 6,191,216) should therefore now be withdrawn.

Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as obvious over Grindley in view of Ganster and further in view of Clemens (US 6,518,359).

The differences between the present invention and anything that can be learned from the Grindley/Ganster combination of references has been discussed

above. The Examiner turns to Clemens for a DMC catalyst. A DMC catalyst will not in any way overcome the differences pointed out above, however. The rejection of claims 4 and 5 under 35 U.S.C. 103(a) as obvious over Grindley in view of Ganster and further in view of Clemens should therefore now be withdrawn.

Claims 7-9 and 18 stand rejected under 35 U.S.C. 103(a) as obvious over Grindly in view of Ganster and further in view of Schumann EP 1,095,993. The Examiner contends that Grindly in view of Ganster show the invention of the claims, except for the process of reacting the ingredients in a reaction nozzle onto a moving substrate. The Examiner relies on Schumann for mixing components in a nozzle. Mixing in a nozzle will not in any way overcome the differences discussed above between the present invention and the disclosures of the Grindly and Ganster references, and the rejection of claims 7-9 and 18 under 35 U.S.C. 103(a) as obvious over Grindly in view of Ganster and further in view of Schumann EP 1,095,993 should be withdrawn.

Claims 1-3, 6-14 and 16-19 stand provisionally rejected for obviousness-type double patenting over claims 1-8 of copending application serial number 10/816,277. It is respectfully requested that further action on this provisional rejection be deferred until it can be determined which application will be allowed first, at which time an appropriate Terminal Disclaimer will be considered.

Applicants note with appreciation that claim 15 is objected to only, and presumably would be allowable if amended into independent form. For the reasons given above, however, it is believed that all of the claims are now in condition for

allowance.

In view of the present remarks it is believed that claims 1-19 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
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I hereby certify that this correspondence is being transmitted via facsimile no. 571-273-8300 addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 9, 2005


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